

REMARKS

Applicant respectfully requests reconsideration and allowance in view of the foregoing amendment and following remarks. In the Office Action, mailed June 04, 2003, the Examiner rejected claims 1-4, 6-10, 17-19, 21-28, 30-35 and 38-45. By this amendment, no claims have been canceled or added, and claim 3 has been amended for the grammatical, non-substantive and non-narrowing reason of deleting a comma. Following entry of this response, claims 1-4, 6-10, 17-19, 21-28, 30-35 and 38-45 will be pending in the application.

Claim Rejections under 35 U.S.C. § 112 (Second Paragraph)

In the Office Action, the Examiner rejected claims 24, 33 and 43 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully traverses the rejections of claims 24, 33 and 43.

A rejection under 35 U.S.C. § 112, second paragraph, is not appropriate when "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). In the Office Action, the Examiner asserts that claims 24, 33 and 43 are unclear as to what types of interfaces are included or excluded through Applicant's use of the phrase "non-standard input/output interface."

Applicant respectfully submits that one of ordinary skill would have no difficulty understanding the meaning of the specification, including the phrase questioned by the Examiner. This is all that is required. The specification clearly discusses both standard and non-standard interfaces, and the examiner has not provided any evidence whatsoever that either contradicts the specification or otherwise establishes that those of ordinary skill at the time of Applicant's invention would not have understood the scope and meaning of the claims.

Absent such evidence, and for at least this reason, the rejection of claims 24, 33 and 43 under Section 112 should be withdrawn.

Claim Rejections under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1, 2, 4, 6-9, 17-19, 21-28, 30-33, 35 and 38-45 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,646,983 to Suffern (hereinafter "Suffern") in view of U.S. Patent No. 5,644,593 to Bailey (hereinafter "Bailey"). Additionally, the Examiner rejected claims 3, 10 and 34 under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Suffern and Bailey in view of U.S. Patent No. 5,640,594 to Gibson et al. (hereinafter "Gibson"). Applicant respectfully traverses the rejections of claims 1-4, 6-10, 17-19, 21-28, 30-35 and 38-45 and notes for subsequent reference the following standards for a proper §103(a) rejection.

A §103(a), or obviousness, rejection is proper only when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains." 35 U.S.C. §103(a). The Examiner must make out a *prima facie* case for obviousness. The mere fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. The *en banc* Federal Circuit has held that "structural similarity between claimed and prior art subject matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions, creates a *prima facie* case of obviousness." *In re Dillon*, 16 U.S.P.Q. 2d 1897, 1901 (CAFC 1990). The underlying inquiries into the validity of an obviousness rejection are: "(1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness." *In re Dembiczak*, 175 F.3d 994, 998, (Fed. Cir. 1999).

Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) (emphasis added). Likewise, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

Inherency

In the office action, the Examiner rejects numerous claims (e.g., 2, 32, etc.) using the theory of inherency. Applicant respectfully asserts that the Examiner has failed to set forth the necessary factual basis for inherency up which a *prima facie* case for obviousness can be made.

The 8th Edition, Revision 1 (February 2003), of the MPEP at section 2112 states the following:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

...

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Applicant requests that the Examiner provide, as required, for each allegation of inherency, "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."

Apparent

In the office action, the Examiner rejects numerous claims (e.g., 6, 27, 39-42, 45, etc.) by stating a particular element or limitation is "apparent." Applicant respectfully asserts that the use of "apparent" throughout the Office Action is confusing, inconsistent and ambiguous. In some instances, it seems that the Examiner is using "apparent" to mean obvious, and in other instances to mean "inherent." Applicant requests that the Examiner restate these "apparent" rejections as either being obvious or inherent.

Suffern in view of Bailey

The 8th Edition, Revision 1 (February 2003), of the MPEP at section 2141.02 states the following:

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore &*

Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983),
cert. denied, 469 U.S. 851 (1984)

Thus, the Examiner may not ignore the plain language of a reference that teaches away from the combination one reference to another.

In the Office Action, the Examiner ignores the plain teachings of the Suffern and Bailey references. As previously noted by Applicant, Bailey describes a problem of the recognized prior art as follows:

[I]n a typical personal computer, an unbuffered UART receives data one bit at a time until an asynchronously framed byte (8 bits of data, 1 start bit and 1 stop bit) is received. The UART then signals the CPU of the personal computer (via a serial interrupt) to indicate that it has received a byte of data. If the CPU does not service the serial interrupt before the next byte of data is received, the previous byte of data is over written and the UART indicates that an overrun error had occurred. Under ordinary conditions, the data is lost. The only way to avoid losing data is to utilize a higher level protocol or software layer which upon detecting the error can negotiate with the transmitting DTE at the remote end to retransmit the lost data or the block containing the lost data. In spite of these higher level protocols, even a small number of overrun errors can significantly degrade the performance the communications link. If the CPU is forced to service a serial interrupt for each byte of data at very high data rates, the frequency of serial interrupts that will occur can account for a significant amount of the CPU time causing the operating system to grind to a halt or make it so sluggish that it will be impractical.

Bailey, col. 3, ll. 11-32. Thus, Bailey teaches that it is desirable to *reduce* the load on a CPU of a typical personal computer. To accomplish this, Bailey provides a modem (DCE 20) which is separate from a personal computer (DTE 10). See e.g., Fig. 1. This modem (DCE 20) has its own CPU and memory. See e.g., Fig. 1 and col. 6, ln. 60 through col. 7, ln. 3.

Suffern, in stark contrast to Bailey, teaches that it is desirable to *increase* the processing load on a CPU. In particular, Suffern describes that the processing of signals for modem functionality can be moved away from a separate modem unit to the microprocessor (CPU) of a host computer, thus reducing the costs for a modem by eliminating the need for separate processors in the modem unit. See, for example, Suffern, col. 1, ll. 60-67.

Suffern and Bailey cannot be properly combined because the objectives of these two

references, as clearly set forth in the references themselves, are completely contradictory. Simply put, one of ordinary skill in the art would not think to combine any part of a system in which the goal is to reduce the load on a personal computer's CPU with a system in which the goal is to increase the processing required of a personal computer's CPU. As such, the Applicant strongly disagrees with the Examiner's assertion that "The [Applicant's] argument is not persuasive because the CPU load is immaterial to the combination of the references as made in the rejection"

The Examiner is not free to pick and choose among various elements of Suffern and Bailey while completely disregarding the fundamental teachings of these references. Such a strategy indicates that the Examiner is using hindsight to reconstruct the Applicant's claimed invention using the Applicant's own teachings as a blueprint. The patent laws are clear that such hindsight reconstruction is simply not permissible.

For at least this reason, Applicant respectfully requests the Examiner to withdraw the rejection of Claims 1, 2, 4, 6-9, 17-19, 21-23, 25-28, 30-33, 35 and 38-45 under 35 U.S.C. 103(a).

Regarding the rejections of claims 3, 10 and 34, the Examiner has failed to make out a *prima facie* case for obviousness because the Examiner provides detail about how Gibson relates to a Ramaswamy reference, not Suffern and Bailey (see, Office Action, p. 9, last line). Assuming, *arguendo*, that the Examiner meant Suffern and Bailey instead of Ramaswamy, the combination of Suffern and Bailey, as discussed above, is improper. Furthermore, Claims 3, 10, and 34 ultimately depend from base Claims 1, 4, and 33. These Claims 1, 4 and 33 should now be in condition for allowance. For at least these reasons, Applicant respectfully requests the Examiner to withdraw the rejection of Claims 3, 10, and 34 under 35 U.S.C. 103(a).

Therefore, for at least these reasons, Applicant respectfully submits that claims 1-4, 6-10, 17-19, 21-28, 30-35 and 38-45 are in a condition for allowance, and respectfully request a Notice to that effect.


Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition of allowance and a Notice to that effect is earnestly solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or

telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

CHARGE STATEMENT: The Commissioner is hereby authorized to charge fees that may be required relative to this application, or credit any overpayment, to our Account 03-3975, Order No. 069509-0302131 (PCTEL-3206-1C).

Respectfully submitted,
PILLSBURY WINTHROP LLP

By: 
Ross L. Franks, Reg. No. 47,233

2550 Hanover Street
Palo Alto, CA 94304-1115
Tel. No.: (650) 233-4897
Fax No.: (650) 233-4545

60345362